

REMARKS AND DISCUSSION

Upon entry of the present amendment, claims 1-6 remain pending in the application, of which, claim 1 is independent, and of which, claims 3-5 are multiple dependent claims. Claims 1 and 4 have been amended by the present amendment.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted.

It is contended that by the present amendment, all bases of objections and rejections set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the objections and rejections is respectfully requested.

Amendments Presented

In the claims: claim 1 has been amended by specifying that the determination means determines whether the dismantling by the dismantling means is allowed, in accordance with an input signal that is input from outside the vehicle.

Claim 4 has been amended by specifying that the fastening member or the fastening portion is formed by at least two detachably fixed members that are formed with materials having mutually different expansion coefficients; with a convex insertion portion formed on a member with a relatively small expansion coefficient, and a concave or hole engaging portion that has a predetermined interference.

Each of claims 1 and 4 has also been amended to overcome the 112 issues.

In the specification: paragraphs [007], [008] and [066] of the specification have been amended for correcting minor editorial errors and for providing express support for the amended claim language. Paragraph [005] has been amended for correcting minor editorial error.

Applicant respectfully submits that the above amendments to the claims are fully supported by the original disclosure including drawings. Applicant also respectfully submits that no new matter is introduced into the application by amending the claims, since the entire subject matter thereof was expressly or inherently disclosed in the original claims, specification and the drawings.

For example, amendments to claim 1 specifying that, "an input signal that is input from outside the vehicle" are supported by paragraph [038], (i.e., page 8, lines 5-8), of the originally filed specification of the present application.

Drawing Issues – Application Papers

Applicant notes for the record that the Examiner has not indicated whether or not the originally-filed drawings have been approved. Applicant respectfully requests formal confirmation from the Examiner that the drawings are approved for publication.

Drawing Objections

In the Office Action (page 2, item 1), the Examiner objected to the drawings under 37 CFR 1.83(a). According to the Examiner's interpretation, the terms appearing in claim 4, line 5,

“a convex insertion portion”, and in claim 4, line 6, “a concave or hole-shaped engagement portion” must be shown in the drawings, or canceled from the claims.

Applicant’s Response:

Applicant respectfully traverses the Examiner’s objection to the drawings, and requests reconsideration and withdrawal thereof, based on the present amendments and arguments.

As stated above, applicant has amended claim 4, herein. Applicant has also amended paragraph [066] of the specification for providing express support for the amended claim language. Applicant respectfully points out that the insertion portion 42a was already described in the specification and shown in the drawings, but was not expressly described as a convex insertion portion until now. Upon careful consideration and in light of the above amendments, applicant respectfully traverses such objection to the drawings, and submits that no change to the drawings is needed in light of the amendments to the claims and specification, and that the objection to the drawings has now been overcome.

Moreover, applicant respectfully submits that the features, “a convex insertion portion”, and “a concave or hole-shaped engagement portion” recited in lines 5-6 of claim 4 are shown in Fig. 6, by reference numerals ‘42a’ and ‘41a’, respectively, and described in paragraph [066] of the originally filed specification.

No new matter is being introduced by the present amendments to the claims and specification.

MPEP section 2163 specifies that “while there is no in haec verba [in the exact words] requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure”; and “the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117”.

The original drawings form part of the disclosure, and amending a specification to explicitly describe a feature which is inherently disclosed does not introduce new matter. Section 2163.07 of the Manual of Patent Examining Procedure states that “Amendments to an application which are supported in the original description are not new matter.”

An amendment that conforms the written specification to the original drawing or claims, or that clarifies something inherent in the original disclosure, does not introduce new matter. See *Litton Systems v. Whirlpool*, 728 F.2d 1423, 221 U.S.P.Q. 97 (CAFC 1984). Where amended material is inherently contained in the original application, it cannot constitute new matter. *Koito Mfg. v. Turn-Key-Tech*, 381 F.3d 1142, 72 USPQ 2d 1190, 1198 (CAFC 2004).

Applicant respectfully suggests that all of the subject matter now claimed was implicitly and inherently disclosed in the original specification, and that one skilled in the art would recognize that the limitation in question is inherent from the original disclosure.

For all of the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of objection to the drawings under 37 CFR 1.83(a).

Claim Rejections – 35 USC §112

Also in the Office Action (page 3, item 3), the Examiner rejected claims 1-6 under 35 USC §112, second paragraph.

Applicant's Response:

The second paragraph of 35 U.S.C. §112 reads as follows:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Additional guidance on this point can be found in the Manual of Patent Examining Procedure. MPEP 2173.02 states as follows, on the subject of the standard under the second paragraph of section 112:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

In the case of *Solomon v. Kimberly-Clark Corp*, *supra*, the court stated:

The definiteness of the language employed must be analyzed - not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art....Determining whether a claim is definite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.

(upholding validity of a claim which included the terms "relatively thick layer" and "substantially thinner layer").

A fundamental principle contained in **35 U.S.C. 112**, second paragraph is that applicants are able to act as their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose, so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP §§ **2111.01, 2173.01**. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ

226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. **112**, second paragraph, would be appropriate. (MPEP 2173.02) See *Morton Int'l, Inc. v. Cardinal Chem.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190 (CAFC 1993). However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. **112**, second paragraph, but the Examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. **112**, second paragraph, rather, the Examiner should suggest improved language to the applicant.

In the case of *In re Venezia*, 189 USPQ 149, 151-152 (CCPA 1976), the Court of Claims and Patent Appeals explicitly addressed the question of whether claim elements including the language "adapted to" were in compliance with the requirements of 35 USC 112. The invention at issue in *Venezia* was a kit of components for building a high-voltage splice connector. The claim at issue in *Venezia* included the terms "capable of being assembled", "adapted to be fitted", "adapted to be affixed", and "adapted to be positioned". The court in *Venezia* stated:

We have reviewed the disputed claims and in particular the language criticized by the examiner and the board. We conclude that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity, and that they are, therefore, definite as

required by the second paragraph of section 112 (citations omitted)
More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims.

Applicant respectfully submits that as presently amended, all of the claims are in full compliance with the requirements of section 112. Further, as stated above, applicant has amended claims 1 and 4, herein. Upon careful consideration and in light of the above amendments, applicant respectfully traverses such rejection, and submits that the rejection is overcome. Applicant respectfully submits that as currently presented, each of claims 1-6 particularly points out and distinctly claims the subject matter of the present invention.

Applicant respectfully submits that in amended claims 1 and 4, all the recitations indicated by the Examiner have been appropriately revised to overcome the 112 issues, except for terms “a predetermined interference” and “interference fitted”, as recited in claim 4.

In this regard, applicant respectfully submits that the term “interference fit” is well-known in the art, and is defined in many technical documents, readily available on the internet, for example, http://en.wikipedia.org/wiki/Interference_fit.

In view of the foregoing, it is clear that a person of ordinary skill in the art would easily understand the meanings of terms “a predetermined interference” and “interference fitted”, recited in claim 4. Therefore, applicant traverses the rejection under 35 USC 112 as it applies to the terms “a predetermined interference” and “interference fitted”, and requests reconsideration

and withdrawal of such rejection, in light of the present arguments.

For all of the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of rejection of claims 1-6 under 35 USC §112, second paragraph.

Claim Rejections – 35 USC §102

Also in the Office Action (page 4, item 5), the Examiner rejected claims 1 and 5 under 35 USC §102(b) as anticipated by Faigle et al. (US 6,412,584).

Applicant's Response:

Applicant respectfully traverses the above ground of rejection, and requests reconsideration and withdrawal thereof, based on the present amendments and arguments.

The Standard for Anticipation

In the case of Motorola, Inc. v. Interdigital Technology Corp., 121 F. 3d 1461 (CAFC 1997), the Court of Appeals for the Federal Circuit stated:

“For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art (citation omitted). ‘The (prior art) reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it’ (citations omitted). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.”

The above-quoted passage is consistent with many previous cases of the Federal Circuit and with MPEP 2131, which reiterate the rule that **in order to anticipate a claim, a reference must teach every element of the claim.**

Applicant respectfully submits that Faigle et al. does not disclose each and every element of applicant's claimed invention.

Moreover, as stated above, applicant has amended claim 1 herein. Upon careful consideration and in light of the above amendments, applicant respectfully traverses such rejection, and submits that the rejection is overcome because Faigle fails to disclose several required features of the claimed invention for the reasons discussed below.

For example, the on-vehicle component fixation-release apparatus, as recited in the amended claim 1 of the present invention has a feature of including "a determination means that determines whether dismantling by the dismantling means is allowed in accordance with an input signal that is input from outside the vehicle".

With including such feature, the claimed invention enables dismantling of the fastening member or the fastening portion to be prevented in a state of timing in which releasing the fixation of the on-vehicle component would be unsuitable, even in the case where a command signal is transmitted from a communication terminal, a base station, or the like, which is outside the vehicle.

In other words, according to the claimed invention, releasing of the fixation of the on-vehicle component can be appropriately performed by determining whether or not the dismantling should be performed in response to a state of the vehicle or a state of occupants in the vehicle from an external point of view.

On the other hand, Faigle et al. discloses a vehicle door opener in which a latch and a hinge of a door are dismantled in response to a signal from a crash sensor. Thus, Faigle et al. fail to disclose the claimed on-vehicle component fixation-release apparatus, as recited in amended claim 1. Also, Faigle et al. fail to disclose features of claim 5 for the reasons provided in relation to claim 1.

Accordingly, the Applicant believes that the amended claim 1 is in condition for allowance because it includes the above-described features which are neither disclosed nor suggested in the references of record, and enables the above-described advantageous effects.

For all of the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 5 under 35 USC §102(b).

Claim Rejections – 35 USC §103

In the Office Action (page 4, item 7), the Examiner rejected claims 2, 3 and 6 under 35 USC §103(a) as being unpatentable over Faigle et al. in view of Byon (US 5,727,288).

Applicant's Response:

As stated above, applicant has amended claim 1 (from which claims 2, 3 and 6 directly or indirectly depend), herein. Upon careful consideration and in light of the above amendments, applicant respectfully traverses such rejection, and submits that the rejection is overcome for the reasons provided hereinabove in relation to claim 1, and further because the deficiencies of Faigle et al. are not overcome by any additional teachings of Byon.

For example, Byon discloses a structure in which a hinge of a door is dismantled when the vehicle body is deformed by a collision and/or overturned.

However, none of the cited references disclose or suggest the features “a determination means that determines whether the dismantling by the dismantling means is allowed in accordance with an input signal that is input from outside the vehicle”, as required by the claimed invention.

Specifically, Faigle et al. and Byon merely disclose a structure for dismantling on-vehicle components in response to the signal generated and transmitted from inside the vehicle. Therefore, no combination of the cited references can obtain the above-described advantageous effect of the claimed invention.

In view of the actual disclosures of the applied references, a person of ordinary skill in the art would not consider it obvious to combine the teachings of Faigle et al. and Byon, as proposed by the Examiner, to provide the claimed invention because the applied references fail to disclose several limitations of the claimed invention.

For all of the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of rejection of claims 2, 3, and 6 under 35 USC §103(a).

Other Matters

The additional references cited by the Examiner on the form PTO-892 included with the Office Action – US Patent Application Publication: US 2004/0195815 to Browne et al. – has

been considered by applicant. However, applicant respectfully submits that each of claims 1-20 distinguishes over the references of record, considered either singly or in combination for the reasons discussed above.

Applicant believes that the currently amended claim 1 should be allowable because it includes several advantageous features, as discussed above, which are neither disclosed nor suggested in the references of record. Also, applicant believes that the claims 2 to 6 should also be allowable due at least to their dependency on the allowable independent claim 1.

Conclusion

Based on all of the foregoing, applicant respectfully submits that all of the rejections set forth in the Office Action have been overcome, and, as presently amended, all of the pending claims are believed to be allowable over all of the references of record, whether considered singly or in combination.

It is applicant's contention that no possible reading of the references, either singly or in any reasonable combination, can be viewed as teaching applicant's claimed invention. Therefore, applicant respectfully requests reconsideration and withdrawal all of the rejections of record, and allowance of the pending claims.

If the Examiner is not fully convinced of the allowability of all of the claims now in the application, applicant respectfully requests that the Examiner telephonically contact applicant's undersigned representative to expeditiously resolve prosecution of the application.

Favorable consideration is respectfully requested.

Respectfully submitted,



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